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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,274	03/27/2001	Wayne Edward Beimesch	390780	6754

7590 05/06/2002
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EXAMINER

ROGERS, DAVID A

ART UNIT	PAPER NUMBER
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2856

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,274

Applicant(s)

BEIMESCH, WAYNE EDWARD

Examiner

David A. Rogers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. The disclosure is objected to because of the following informalities: Page 5, lines 30-31 states "Each of the five 20 gram samples...as shown in the Figure". It is not clear what figure this sentence is referring. Neither figure 1 nor figure 2 show 5 bags with samples being poured into them. Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 5, 6, and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5,140,845 to Robbins. Robbins clearly discloses a method to test for volatile organic compounds (VOCs) using both a sealable bag to store a material and a flame ionization detector (FID) to perform the tests.
4. With regard to claims 1 and 7 Robbins discloses that it is beneficial to store the bag at an optimum temperature in order that the headspace reach a state of equilibrium (column 5, lines 1-6). With regard to claim 4 Robbins discloses that time is a relevant factor to reach the desired equilibrium in the headspace (column 4, lines 57-58). With regard to claim 5 Robbins discloses that the initial mass of the sample is directly related to the measured equilibrium headspace concentration (equation 5, equation 7).
5. Robbins discloses the claimed invention except for the recitation of material storage for 5-24 hours, initial material mass of 1-100 grams, and a temperature range from 5° C-100° C. It is

well known in the art that temperature affects the mass transfer coefficient, and, therefore, equilibrium of the headspace. One of ordinary skill in the art would be highly motivated to ensure that the material is subjected to its expected operating conditions in order to accurately determine if VOCs are being released. The range limitations recited represent optimum ranges in order to reach headspace equilibrium and would be determined on a case-by-case basis for the material being tested. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. See *In re Aller*, 105 USPQ 233.

6. With regard to claim 6 Robbins clearly discloses that storage tanks are a source of VOCs (column 1, lines 16-20).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins as applied to claim 1 above, and further in view of U.S. Patent 5,913,588 to Legros et al. Robbins teaches the testing for VOCs from a sample material using a sealable bag and an FID. Robbins does not teach that fluid bed dryers are a source of VOCs. Legros teaches that bed drying may produce VOCs. Legros does not teach the testing for VOCs using a sealable bag and an FID. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

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teachings of Robbins with the teachings of Legros to obtain a method to test for VOCs using a FID where the VOCs originated from a material subjected to bed drying.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins as applied to claim 1 above, and further in view of U.S. Patent 5,576,285 to France et al. Robbins teaches the testing for VOCs from a sample material using a sealable bag and an FID. Robbins does not teach that spray dryers are a source of VOCs. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Robbins with the teachings of France to obtain a method to test for VOCs using a FID where the VOCs originated from a material subjected to spray drying.

10. With further regard to claims 2, 3, and 6 it is known that any method to test for VOCs is be independent of the material processing system. It has been held that to be entitled to weight in a method claim the recited structure limitations therein must affect the method in a manipulative sense. They cannot amount the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

11. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins in view of U.S. Patent 4,930,906 to Hemphill. Robbins clearly teaches the use of a sealable bag for the storage of materials emitting VOCs. Robbins does not teach the inclusion of instructions with or on the bag. Hemphill teaches a sealable bag with instructions for using the bag. Hemphill does not teach using a sealable bag to store material emitting VOCs. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Robbins with the teachings of Hemphill to obtain a sealable bag with instructions to store material emitting VOCs.

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12. Hemphill teaches that the instructions for use of the bag are included with the bag. One of ordinary skill in the art would be highly motivated to ensure that appropriate instructions related to the intended use of the bag would be included as a matter of design choice.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Rogers whose telephone number is (703) 305-4451. The examiner can normally be reached on Monday - Friday (0730 - 1600).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on (703) 305-4705. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

dar *R6*
May 1, 2002


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800